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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1949.

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No. 325.

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FORREST H. SMITH, ET AL., *Petitioners*,

v.

GENERAL FOUNDRY AND MACHINE COMPANY, ET AL., *Respondents*.

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## BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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There are no grounds stated in the petition herein, or in the petitioners' brief, that establish any basis for bringing this case within the provisions of Section 5 of Rule 38 of this Court.

This is simply an ordinary patent case involving the usual issue of infringement, which has been disposed of by summary judgment in the District Court below (R. 51) on well settled principles under Rule 56 of the Federal Rules of Civil Procedure, and which has been reviewed and affirmed by the Court of Appeals for the Fourth Circuit (174 F. (2d) 147; R. 136). The patents in suit have not been litigated in any other circuit.

The only ground advanced for granting the petition (Petition, page 9) is an allegation that "there is direct conflict between the decision here and the rule of the Circuit Court of Appeals for the Third Circuit in *Hart* v. *Recordgraph*," 169 F. (2d) 580 (C. C. A. 3rd, 1948), regarding the granting of motions for summary judgment. The rule in *Hart* v. *Recordgraph*, however, is merely to the effect that an affidavit cannot be relied on to determine a material fact at issue, with which everyone should agree, but which has no bearing whatever on the present case where there has never been any question as to any of the affidavits filed by either side, and where the facts relied on by the District Court and the Court of Appeals in deciding the issue of infringement are clearly established of record and acknowledged by both sides without question.

Moreover, petitioners' statement of the question presented in this case (Petition, page 8) does not even infer that there was any material fact at issue here, as in *Hart* v. *Recordgraph*, *supra*, but instead attacks the action of the Court of Appeals in deciding the ultimate issue of infringement. What the petition in this case is really requesting is a reconsideration by this Court of the issue of infringement which has been decided adversely to petitioners in both the District Court and the Court of Appeals below, and which neither requires nor warrants any further consideration.

**Statement of the Case.**

Petitioners' complaint in this case charged respondents with infringement of two patents Nos. 1,811,980 and 2,051,348 (R. 9 and 17), which cover a tobacco barn or drying house equipped with a plurality of small unit oil burners spaced throughout the drying house to obtain an alleged improvement in uniformity of heating. That the distinguishing feature of the patents in suit was this different multiple arrangement of small unit burners to obtain uniformity of heating, in contrast with the conventional cen-

tral heating type of system commonly employing wood-burning furnaces, is clear on the face of the patents, and was readily recognized by both the District Court and the Court of Appeals below.

Respondents' structure consists simply of a straight forward substitution of either one or two large capacity oil burners as central heating units (*which are acknowledged in patent No. 1,811,980 in suit to be old in the art*) in a tobacco barn in place of either one or two conventional wood-burning furnaces. Petitioners admitted in the District Court that respondents' single unit installation did not infringe the patents in suit, but alleged that the two burner installation of the same type did infringe. There is no real difference in function or arrangement of respondents' oil burners when two are used instead of one, and as a matter of fact the two oil burner installations are only used by respondents in the relatively few instances where very large barns require the greater heating capacity of two burners.

Complete diagrams, photographs, and descriptions of respondents' installations were before both the District Court and the Court of Appeals, together with actual full size embodiments of respondents' oil burners, and it is admitted by petitioners that these installations were fully disclosed of record. Also, the file wrappers and contents of each of the patents in suit were before both the District Court and the Circuit Court of Appeals. Petitioners have never attempted to show any facts that would contradict any material fact presented in support of respondents' motion for summary judgment.

The District Court, after finding that there was no genuine issue as to any material fact, and after comparing respondents' installations with the patents in suit, granted respondents' motion for summary judgment on the ground that the patents in suit were not infringed, and the Court of Appeals reached the same conclusion.

## Argument.

SUMMARY:

I. There is no genuine issue as to any material fact regarding the patents in suit or the structure accused of infringement.

II. It has always been held that the question of infringement may be determined as a question of law when there is no genuine issue as to the material facts.

III. The Court of Appeals in finding no infringement did not read into the claims of the patents in suit any additional limitations, but simply recognized the reasonable and intended meaning of the claims in the light of their specifications.

IV. It is well settled that the claims of a patent are always to be read and interpreted in the light of the patent specification.

V. As it is admitted in this case that the structure accused of infringement is fully disclosed of record, and as the patents in suit are clear on their face, it was entirely proper for the District Court and the Court of Appeals to compare the accused structure with the patents in suit and decide the issue of infringement as a matter of law on respondents' motion for summary judgment.

### I.

As this is a patent infringement suit the material facts of primary importance are the texts of the specification and claims of the patents in suit, and the details of the structure accused of infringement. Complete file wrappers of both of the patents in suit were made of record at the time respondents' motion for summary judgment was filed, and complete information regarding the structure accused of infringement was made a part of the record at the same

time. Petitioners have never raised any question regarding the sufficiency of the record in this respect, and, as previously noted, petitioners admit that the structure accused of infringement is fully disclosed of record.

## II.

The decisions of this Court clearly establish that the question of infringement is an ultimate issue which may be decided as a question of law when there is no genuine issue as to the material facts. This rule was recognized by this Court in the case of *United States* v. *Esnault-Pelterie*, 303 U. S. 26, 30, (1938), in which the Court said:

> "We are not unmindful of the rule that where, with all the evidence before the court, it appears that no substantial dispute of fact is presented, and that the case may be determined by a mere comparison of structures and extrinsic evidence is not needed for purposes of explanation, or evaluation of prior art, or to resolve questions of the application of descriptions to subject matter, the questions of invention and infringement may be determined as questions of law. (*Citing cases*)"

The rule was also clearly stated by this Court in the earlier case of *Singer Mfg. Co.* v. *Cramer*, 192 U. S. 265, 275 (1904), as follows:

> "As in each of the patents in question it is apparent from the face of the instrument that extrinsic evidence is not needed to explain terms of art therein, or to apply the descriptions to the subject-matter, and as we are able, from mere comparison to comprehend what are the inventions described in each patent, and from such comparison, to determine whether or not the Diehl device is an infringement upon that of Cramer, the question of infringement or no infringement is one of law, and susceptible of determination on this writ of error."

To the same effect is *Vulcan Corporation* v. *International Shoe Machine Corporation*, 68 F. Supp. 990 (D. C. Mass., 1946), affirmed per curiam, 158 F. (2d) 520 (C. C. A. 1st,

1946), certiorari denied, 330 U. S. 825, (1947); and *Steigleder* v. *Eberhard Faber Pencil Co.*, No. 4411, decided August 9, 1949 (C. C. A. 1st).

It is clear that both the District Court and the Court of Appeals below were convinced from the record that infringement could not be established in this case, and petitioners, although having ample opportunity to do so, have never made the least effort to show that any extrinsic evidence exists which would or even could alter this conclusion.

## III.

There is a contention repeated over and over again in the petition and brief by petitioners herein, that the Court of Appeals in finding no infringement read into the claims of the patents in suit additional limitations. The additional limitations said by petitioners to have been read into the claims are stated in the petition as follows (Petition, page 4):

> "The Court of Appeals in holding that the claims were not infringed held that the word 'plurality', although including two, should be read in connection with the drawings which show fifteen burners because, according to the Circuit Court of Appeals, a greater number than two burners were required to obtain the 'prime purpose' of petitioners' invention, namely, the uniform distribution of heat."

This contention may be judged best by simply comparing the opinion of the Court of Appeals, which reads in pertinent part as follows:

> "The principles governing the question of infringement are well established and when they are applied to the facts of this case, it becomes clear that the defendant does not employ the system that the plaintiff has devised.
>
> "This is so, *not merely because the defendant uses only two instead of many burners*, but because the defendant's arrangement is not intended to and does not

effect the purpose which the patent structure was expressly designed to accomplish. We have seen that the prime purpose of the patent was to do away with a central heating system, with its loss of heat and lack of uniformity of temperature in various parts of the drying house and to substitute a plurality of individual heating units spaced apart and variously located under the flue inside the warehouse so that the heat would be evenly distributed and easily controlled throughout the building. But the defendants have not abandoned the central heating system. It is true that they employ fuel burners inside the barn, as was shown in patents prior to those in suit, and that in the accused structure, two burners are employed; but these are centrally located side by side where the two ends of the flue system are brought to the middle portion of the barn. There is no attempt to space the burners apart and to supply heat at various points so as to maintain a uniform temperature throughout. Only one and sometimes two burners, depending upon the size of the barn, are used, and these of necessity are of much greater power than the burners of the patent under its system of distributing the sources of heat throughout the building." (Italics added.)

* * * * *

"This discussion also shows that claim 3 of the second patent was not infringed. If the language of the claim is to be taken literally, *it is plain that the defendants do not use a plurality of heat units in the building 'arranged in series extending around adjacent to the walls thereof'; but it is more important that the defendants, as we have shown, are not using the heating system which the plaintiff devised.* It is also clear that the defendants, in connecting the ends of their flue system to the burners by iron elbows, are following the early practice of connecting the flues with a central heating system rather than the boxing system of the second patent." (Italics added.)

It could hardly be clearer that it was only in passing that the Court of Appeals even mentioned the word "plurality" in the claims of the patents in suit, and that the holding of non-infringement is based on the reasonable and intended

meaning and scope of the claims of the patents in suit, quite apart from any significance that the word "plurality" may have.

IV.

That the meaning and scope of patent claims are to be determined, as the Court of Appeals has done here, in the light of the accompanying specification, is not open to question. The decision of this Court in *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, 217 (1940), states the rule as follows:

> "The claims of a patent are always to be read or interpreted in the light of its specifications, (*citing cases*); and we may assume that if in the present case the specifications and claims of the patents were to be interpreted without reference to its file wrapper history, *the webs referred to in the claims are the webs described in the specifications . . .* " (Italics added.)

This rule is consistently recognized and followed by the several Courts of Appeal, as in *Wheeling Stamping Co.* v. *Standard Cap & Moulding Co.*, 155 F. (2d) 6 (C. C. A. 4th, 1946), certiorari denied, 329 U. S. 764 (1946).

*Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271 (1949), cited by petitioners, is not to the contrary. The *Graver* case merely holds that technically specific terms of a claim cannot be restricted in the light of its specification to save the validity of the claim, which is an entirely different thing from determining the reasonable and intended meaning of terms of general description in a claim by reading and interpreting the claim in the light of its specification, as the Court of Appeals has done here, and as this Court has repeatedly said should be done.

V.

The petition in this case does not present to this Court for the first time the question of whether summary judgment may properly be granted in a patent infringement

suit on the ground of non-infringement. An exactly similar situation was presented quite recently in *Vulcan Corporation* v. *International Shoe Corporation, supra,* and this Court denied certiorari.

Moreover, the principles governing the granting of summary judgment are well settled in the federal courts, and this is so in regard to patent cases as well as any other type of case. All of the following patent cases have been decided by summary judgment: *Steigleder* v. *Eberhard Faber Pencil Co., supra; Rubinstein* v. *Silex Co.,* 73 F. Supp. 336 (D. C. S. D. N. Y., 1947); *Juniper Mills, Incorporated* v. *J. W. Landenberger & Co.,* 6 F. R. D. 463 (D. C. E. D. Penn., 1947); *Brown* v. *Ford Motor Company,* 57 F. Supp. 825 (D. C. E. D. Mich., 1944); *Allen* v. *Radio Corporation of America,* 47 F. Supp. 244 (D. C. Del., 1942); *John T. McCoy, Inc.* v. *Schuster,* 44 F. Supp. 499 (D. C. S. D. N. Y., 1942); and *S. R. Leon, Inc.* v. *Parfums Schiaparelli, Inc.,* 35 F. Supp. 641 (D. C. S. D. N. Y., 1940). Where the issue of infringement is involved, the principles were well stated by the First Circuit in the *Steigleder* case, as follows:

> "Where it is apparent that there is no genuine issue of fact bearing on infringement and the structure and mode of operation of the accused device are such that they may be readily comprehended by the court, and compared with the invention described and claimed in the patent without the need of technical explanation by the testimony of expert witnesses, then the court if satisfied that there is no infringement, should give summary judgment for the defendant instead of subjecting the parties to the expense of a trial."

**Conclusion.**

The ultimate issue of infringement in the present case was properly determined by the District Court and the Court of Appeals below as a matter of law on respondents' motion for summary judgment. The alleged conflict regarding the law of summary judgments on which the peti-

tion in this case purports to be based is clearly without substance, and the authorities cited by petitioners are not in point and raise no question regarding the decisions of the District Court and Court of Appeals herein.

It is respectfully submitted that the petition fails to advance any proper ground for granting a writ of certiorari in this case; and in particular fails to show any conflict of opinion among the several Courts of Appeal, or any error herein by the Court of Appeals for the Fourth Circuit, regarding summary judgment procedure, or any other basis that would warrant exercise by this Honorable Court of its supervisory authority.

It is submitted that the petition should be denied.

Respectfully,

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